

Amendments to the Drawings

Substitute the enclosed drawing sheet 2/5 for the corresponding drawing sheet originally filed with the application. The attached drawing sheet 2/5 includes changes to FIG. 2, and is explained below in the Remarks section of this Response.

Attachment: Replacement Sheet 2/5

Annotated Sheet showing change circled in red.

Remarks

Entry of the Amendments presented, reconsideration of the drawings, specification and claim objections, as well as the claims rejections, are respectfully requested. Claims 1-13, 15-41, 43-54 & 56 remain pending.

Initially, FIG. 2 is amended in drawing sheet 2/5 to correct a typographical error noted by the Examiner in the Office Action. Specifically, the spelling of “continue” is corrected as circled in red on the annotated drawing sheet. Based on this amendment, withdrawal of the drawings objection is respectfully requested.

With respect to the specification objection, the sentence at page 8, lines 12-14 is amended to clarify its meaning as requested by the Examiner. Based on this amendment, withdrawal of the specification objection is respectfully requested.

With respect to the claims objections, claims 22, 23 & 32-42 are amended herein as suggested by the Examiner in the Office Action. Based on these amendments, withdrawal of the claims objection is respectfully requested.

Original claims 1-14, 15-24, 25-30 & 43 were rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. Without acquiescing to this rejection, Applicants note that the independent claims presented herewith are amended to specify a technique for managing resource allocation within an intellectual property portfolio employing a computer tracking system. The functionality recited in Applicants’ independent claims 1, 15, 25, 31, 43, 44 & 56 is now tied to this computer tracking system. Further, Applicants’ independent claims specify employing the computer tracking system to provide a report indicative of the difference between the actual resource usage and the resource allocation by technology areas of interest, and that this report is for use in managing resource allocation of the intellectual property activity. Applicants respectfully submit that the generation of this report as recited in Applicants’ claimed processing is a useful, concrete and tangible result falling within the terms of 35 U.S.C. §101. Thus, based upon the amendments submitted herewith, reconsideration and withdrawal of the 35 U.S.C. §101 rejection is respectfully requested. With respect to independent claim 25, Applicants note that the amended claim presented herewith recites a computer memory which includes a data structure for facilitating managing resource allocations within an intellectual

property portfolio. Thus, the data structure and its functionality are positively recited in the independent claim. The relationship between the first field and the second field is that a comparison of information within those fields facilitates managing of the resource allocations for the intellectual property activity within the intellectual property portfolio. Thus, reconsideration and withdrawal of the 35 U.S.C. §101 rejection to this claim (and its dependencies) is also requested.

Substantively, claims 1-8, 11-14, 15-17, 20-24, 25, 29-30 & 43 were rejected under 35 U.S.C. §102(b) as being anticipated by an article by David Hsu and Tim Bernstein entitled “Managing the University Technology Licensing Process: Findings From Case Studies” (referred to herein as “Hsu”), while claims 9-10, 18-19 & 26-28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hsu, and claims 31-42, 44-55 & 56 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nummelin et al. (U.S. Patent No. 6,308,164; hereinafter Nummelin) in view of Hsu. Each of these rejections is respectfully, but most strenuously, traversed to any extent deemed applicable to the claims presented herewith.

By this paper, Applicants’ independent claims are amended to more particularly point out and distinctly claim the subject matter of their invention. These amendments are submitted in a *bona fide* attempt to advance prosecution of this application. Support for the amended language can be found throughout the application as filed. For example, reference the discussion at page 6, line 14 – page 8, line 8; page 12, line 16 – page 13, line 28; and page 15, lines 23-26, as well as FIGS. 1-4. Thus, no new matter is added to the application by any amendment presented.

Applicants’ invention is directed in one aspect (e.g., claims 1, 15, 31, 43, 44 & 56), to a technique for managing resource allocations within an intellectual property portfolio. By way of example, claim 1 specifies: determining available resource capacity for an intellectual property activity managed by a computer tracking system; assigning technology tags to the activity in the computer tracking system, the technology tags representing different technology areas of interest; apportioning the available resource capacity for the activity to the different technology areas of interest in the computer tracking system based on a priority value assigned to each technology area of interest; obtaining actual resource usage by technology area from the computer tracking system; and employing the computer tracking system in providing a report indicative of the difference between the actual resource usage and the resource allocation by

technology areas of interest for use in managing the resource allocation for the intellectual property activity.

Initially, Applicants note that the goal of the Hsu article, and that of the present invention are distinct. In Hsu, it is noted that university Technology Licensing Offices (“TLOs”) face a dynamic environment in which the number of technology disclosures is rapidly increasing, while the available resources for licensing technologies do not keep pace. Adapting new, strategic plans for licensing is therefore vital. The Hsu paper therefore develops an analytical framework for the licensing process. Drawing on the analytical framework in case studies, the Hsu article concludes with recommendations to help TLOs continue to improve their licensing strategies in the challenging environment. In contrast, Applicants’ invention notes that current intellectual property portfolios are most often developed tactically as the result of solving day-to-day technical problems associated with manufacturing, development, etc. In order to build a premier intellectual property portfolio, techniques for targeting strategic (e.g., products, standards, etc.) patent or other intellectual property development and opportunities are believed desirable by Applicants, as well as techniques for measuring invention development progress. Applicants’ invention addresses these goals by providing a proactive intellectual property development and measurement approach using a computer tracking system and the processing functionality recited by Applicants. Based upon these different goals, Applicants respectfully submit that one of ordinary skill in the art would not have viewed their approach as anticipated by or obvious over the teachings of the Hsu article.

More particularly, a careful reading of the Hsu article fails to uncover any teaching or suggestion of numerous aspects of Applicants’ approach as recited in the independent claims presented. For example, Applicants’ approach includes assigning technology tags to the intellectual property activity in the computer tracking system. These technology tags represent different technology areas of interest. There is no teaching or suggestion in Hsu of specifically assigning technology tags to the activity in a computer tracking system. In Applicants’ approach, the technology tags break the activity down into different technology areas of interest. In this regard, the Office Action references page 1, paragraph 3 of Hsu. Applicants respectfully traverse this characterization of the teachings of Hsu. In page 1, paragraph 3, Hsu is discussing targeting of promising technologies for which the market has failed to pair willing buyers and sellers. In addition, technologies are addressed that are not sufficiently developed to be of

interest to companies or potential investors. Although characterizing different technologies, Applicants respectfully submit that this does not equate to their process of actually assigning technology tags (i.e., technology identifiers) to the activity in the computer tracking system. Identifying whether a given technology is either promising or embryonic is simply a different process than breaking an activity down by technology so that different technology areas of interest are identified in the computer tracking system.

Still further, Applicants' independent claims recited apportioning the available resource capacity for the activity to the different technology areas of interest in the computer tracking system. The word "apportioning" means to make a proportionate division or distribution of. Thus, in Applicants' claimed process, the available resource capacity for the activity is divided among the different technology areas of interest in the computer tracking system. Further, Applicants specify that this apportioning of available resource capacity is based on a priority value that has been assigned to each technology area of interest. A careful reading of Hsu fails to uncover any analogous teaching or suggestion. In this regard, the Office Action references page 3, paragraph 3 of Hsu. However, it is submitted that an individual decision whether or not to file a patent application is a distinct process from Applicants' functionality of apportioning resource capacity across the different technology areas of interest. Applicants respectfully submit that there is simply no express apportioning of available resource capacity across different technology areas of interest in Hsu, let alone based on a priority value assigned to each technology area of interest.

Still further, Applicants' independent claims recite employing the computer tracking system to provide a report indicative of the difference between the actual resource usage and the resource allocation by technology areas of interest. No similar report is generated by Hsu. In accordance with Applicants' approach, after allocation of the available resource capacity in the computer tracking system to the different technology areas of interest, Applicants monitor actual resource usage by technology area, and then generate a report indicative of the difference between the actual resource usage and the previously allocated available resource for the technology area of interest. This report is then used to manage future resource allocation for the intellectual property activity, for example, to dynamically adjust the intellectual property activity going forward. Again, no similar functionality is believed taught or suggested by Hsu.

For at least the above reasons, Applicants respectfully submit that their invention as set forth in the independent claims presented herewith was not anticipated by the teachings of Hsu, nor rendered obvious to one of ordinary skill in the art based thereon.

The dependent claims are believed allowable for the same reasons as the independent claims, as well as for their own additional characterizations.


With respect to the obviousness rejection of claims 31-42, 44-55 & 56 over Nummelin in view of Hsu, Applicants respectfully traverse the combination as somehow suggesting their claimed invention. Neither Nummelin nor Hsu disclose assigning technology tags to the activity being managed, wherein the technology tags represent different technology areas of interest. Further, neither reference teaches or suggests apportioning an available resource capacity for the activity to the different technology areas of interest in the computer tracking system based on a priority value assigned to each area of interest. There is simply no apportioning *per se* in either Nummelin or Hsu. Still further, Applicants submit that neither reference discloses employing a computer tracking system to provide a report indicative of the difference between an actual resource usage and the resource allocation by technology areas of interest. For all of these reasons, Applicants respectfully request reconsideration and withdrawal of this obviousness rejection.

With respect to data structure claims 25-30, Applicants respectfully traverse the anticipation rejection thereof based on Hsu. A careful reading of Hsu fails to uncover any discussion of a data structure *per se*, let alone a data structure as recited by Applicants in independent claim 25. Further, Applicants note that the Office Action provides no reference at page 11 to specific teachings of Hsu deemed somehow applicable to their data structure claim. Absent such support, Applicants respectfully submit that the Office Action fails to state a *prima facie* case of anticipation against claims 25-29.

For at least these reasons, Applicants respectfully submit that all claims are in condition for allowance, and such action is respectfully requested.

If a telephone conference would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided.

Respectfully submitted,



Kevin P. Radigan
Attorney for Applicants
Registration No.: 31,789

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HESLIN ROTHENBERG FARLEY & MESITI P.C.
5 Columbia Circle
Albany, New York 12203-5160
Telephone: (518) 452-5600
Facsimile: (518) 452-5579

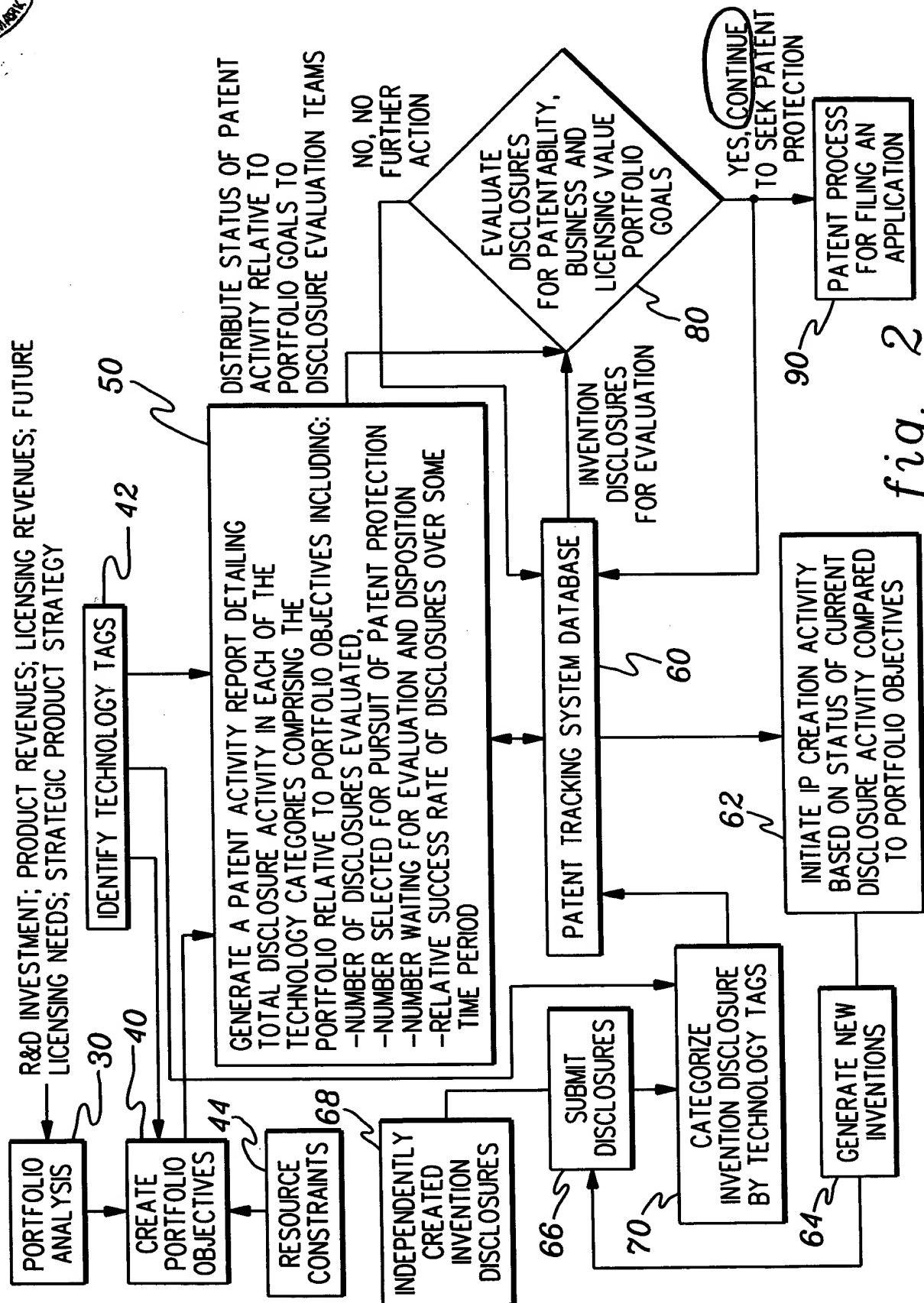


fig. 2